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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,857	12/01/2003	Sharon Lesk	7288-102/10312532	2832
167 7590 03/10/2009 FULBRIGHT AND JAWORSKI LLP 555 S. FLOWER STREET, 41ST FLOOR LOS ANGELES, CA 90071				
EXAMINER				
GEHMAN, BRYON P				
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3728				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/725,857

Applicant(s)

LESK ET AL.

Examiner

Bryon P. Gehman

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3.5 and 7-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3.5 and 7-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Claim 1 is objected to because of the following informalities: In line 8, a period is maintained where it should be deleted due to the amendment. Appropriate correction is required.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 9 is finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In line 2, the recitation of "the grooved ring is detachable" has been previously defined in claim 8, line 7, and comprises double recitation.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 5, 7-9, 12-15, 18 and 22-24 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hinrichs (627,231) in view of Sakamoto. Hinrichs discloses a container or receptacle (A) adapted to be received in a motor vehicle drink holder, the container or receptacle comprising a closed bottom, a top with an opening

and a sidewall that connects the bottom and the top, and a grooved ring (defined by B1 and B2) press fitted into the opening of the top, the grooved ring having an outer wall (B2) and an inner wall (B1). Hinrichs does not disclose the outer and inner walls being at different distances above the closed bottom. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the walls with heights of a varied degree as claimed, as such is not accorded any particular function or purpose in the original disclosure and such a modification would not provide an inventive concept if none is so described. Hinrichs further does not disclose a support means. However, Sakamoto discloses a plant stem support means (14) comprising a set of prongs (24) disposed in a plant stem receptacle. To modify the container of Ho employing the prongs of Sakamoto would have been obvious in order to support plant stems, as suggested by Sakamoto. "A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int 'l v. Teleflex Inc.*, 127 S.Ct. 1731, 82 USPQ2d at 1396. The variable whether the container or receptacle of Hinrichs being adapted to being received in a motor vehicle drink holder pertains to their size, and to any degree the container or receptacle of Hinrichs is not inherently sized corresponding to being received in a drink holder, to size either a container, receptacle or a drink holder sufficient to have the one fit in the other would have been obvious, as plant containers of a size to be capable of being received in a conventional drink holder have been long known in the art. A change in size is generally recognized as being within the level of ordinary skill in the art. See *In re Rose*, 105 USPQ 237 (CCPA 1955).

As to claims 5 and 8, Hinrichs discloses the ring as detachable and having a groove.

As to claim 7, the container of Hinrichs is inherently configured to stand on its own.

As to claim 8, the receptacle of Hinrichs is cup-shaped, as are all flower pots.

As to claims 12-15 and 22-23, Sakamoto disclose the supporting means (15) being removably connected at the bottom of its receptacle. However, applicants claim the relatively permanent and impermanent connections as being interchangeable. To provide an element as permanent or impermanent are the two options, and to render the element either would have been obvious to one of ordinary skill to obtain the desired permanence or removability.

As to claims 18 and 24, Hinrichs discloses a complete circumference ring.

6. Claims 10 and 11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hinrichs in view of Sakamoto. The mechanical combination has been explained above. To locate any article sized to fit within a motor vehicle drink holder falls within the level of common sense, and the location of any article therein would not in itself be inventive.

As to claim 11, to subsequently remove the plant container from the drink holder to display the plant container externally of the motor vehicle would have also been an obvious manipulation to one of ordinary skill in the field of using plant containers.

7. Claims 1, 3 and 12-17 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hinrichs in view of Stone (2,057,856). Hinrichs discloses a container or receptacle (A) adapted to be received in a motor vehicle drink holder, the container or receptacle comprising a closed bottom, a top with an opening and a sidewall that connects the bottom and the top, and a grooved ring (defined by B1 and B2) press fitted into the opening of the top, the grooved ring having an outer wall (B2) and an inner wall (B1). Hinrichs does not disclose the outer and inner walls being at different distances above the closed bottom. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the walls with heights of a varied degree as claimed, as such is not accorded any particular function or purpose in the original disclosure and such a modification would not provide an inventive concept if none is so described. Hinrichs further does not disclose a support means. However, Stone discloses a plant stem support means comprising a frog (10) that is permanently connected to its container. To modify the plant container of any one of Ho, Borah and Hinrichs employing the frog of Stone would have been obvious in order to support plant stems therein, as suggested by Stone.

As to claims 12, 14 and 16, Stone discloses the supporting means (10) being permanently connected to the bottom of the receptacle. To provide the supporting means as a permanent connection would have been obvious to maintain the supporting means with the receptacle. However, with respect to claims 13, 15 and 17, applicants claim the relatively permanent and impermanent connections as being interchangeable. To provide an element as permanent or impermanent are the two options, and to render

the element either would have been obvious to one of ordinary skill to obtain the desired permanence or removability.

8. Claims 10 and 11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hinrichs in view of Stone. The mechanical combination has been explained above. To locate any article sized to fit within a motor vehicle drink holder falls within the level of common sense, and the location of any article therein would not in itself be inventive.

As to claim 11, to subsequently remove the plant container from the drink holder to display the plant container externally of the motor vehicle would have been an obvious manipulation to one of ordinary skill in the field of using plant containers.

9. Claims 19-20 and 25-26 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the art as employed against claims 1 and 9 above and further in view of Matthews (6,516,563). Matthews discloses a detachable grooved ring (24) disposed about the top of a plant and having a groove (30 and/or 32) that is discontinuous or extends partially around the ring. To modify the plant container of the previous combination employing the ring with a groove as taught by Matthews would have been obvious in order to provide an adjustable container for nutrients for the plant, as suggested by Matthews.

10. Claims 21 and 27 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the art as employed against claims 1 and 9 above and further in view of Holtkamp Jr. (5,477,640). Holtkamp discloses a detachable grooved ring (12 or between 14 and 22) disposed about the top of a plant and having a groove (containing air freshener 32 or containing 12 and 32) extending completely around the ring. To modify the plant container of the previous combination employing the ring with a groove as taught by Holtkamp Jr. would have been obvious in order to provide an air freshener capability to the plant container, as suggested by Holtkamp Jr..

11. Claim 28 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hinrichs. Hinrichs discloses a container comprising a receptacle (A), the receptacle comprising a closed bottom, a top with an opening and a sidewall that connects the bottom and the top, and a ring (defined by B1 and B2) sized to be press fit into the opening of the top, the ring having a groove between an outer wall (B2) and an inner wall (B1) capable to hold liquid, the outer wall adjacent the side wall of the receptacle. To render the receptacle "adapted to be received in a motor vehicle drink holder" would pertain to the sizing of the bottom portion (14). It has been long held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. See *In re Hutchison*, 69 USPQ 139. "When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has a good reason to pursue the known options

within his or her technical grasp. If this leads to the anticipated success, it is likely the product is not of innovation but of ordinary skill and common sense. In that instance, the fact that a combination was obvious to try might show it was obvious under 35 U.S.C. 103. *KSR Int 'l v. Teleflex Inc.*, 127 S. Ct. 1731, 82 USPQ2d at 1396. It would have been an obvious matter of design choice to provide the prior art container of a particular desired size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. See *In re Rose*, 105 USPQ 237 (CCPA 1955). Hinrichs also does not disclose the outer and inner walls being at different distances above the closed bottom. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the walls with heights of a varied degree as claimed, as such is not accorded any particular function or purpose in the original disclosure and such a modification would not provide an inventive concept if none is so described, so such is apparently a matter of design choice.

12. Applicant's arguments with respect to the remaining claim have been considered but are moot in view of the new or rearranged grounds of rejection. The reliance on the relative height of the inner and outer walls is not found convincing, while such is shown in the drawings, no original criticality was accorded the wall height, and such was not deemed of any note until well into prosecution, not from any original intent of criticality in the original filing. Accordingly, such is treated as disclosed.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Tuesday through Thursday from 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Bryon P. Gehman/
Primary Examiner, Art Unit 3728

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BPG